

REMARKS

A. Status of the Claims

Claims 1-4 were pending at the issuance of the present Office Action. Claim 1 is amended as discussed below. No new matter has been added as a result of this amendment. Claims 2 and 4 have been canceled without prejudice or disclaimer. Claim 3 has been withdrawn as being drawn to a non-elected invention.

B. Claim Rejections – 35 USC §112, first paragraph

Written Description

Claims 1-2 and 4 are rejected under 35 USC §112, first paragraph as allegedly failing to comply with the written description requirement. In particular, the Action contends that not all “acute or chronic degenerative condition or disease of the eye” or all possible histone deacetylase (HDAC) inhibitors were known to Applicant at the time of filing the instant application. Without acquiescing to the propriety of the Action’s contention, Claim 1 has been amended to recite “primary open angle glaucoma” rather than “acute or chronic degenerative condition or disease of the eye,” and to recite particular histone deacetylase (HDAC) inhibitors, all of which are mentioned on page 6, line 15-16 of the present application. Primary open angle glaucoma is described in the specification on page 1, for example. The amendment to claim 1 is made solely to expedite prosecution. Applicant respectfully requests reconsideration of the claims in view of the amendment to claim 1.

Enablement

Claims 1-2 and 4 are rejected under 35 USC §112, first paragraph, because the specification allegedly fails to enable one of skill in the art to use the invention commensurate in scope with the claims. The Action concedes that the specification is “enabled for the treatment of a few degenerative conditions of the eye using a few histone deacetylase inhibitors” (Office Action, page 5). Claim 1 has been amended as discussed above to recite

“primary open angle glaucoma” and particular HDAC inhibitors. Accordingly, Applicant respectfully requests reconsideration of the claims in view of the amendment to claim 1.

C. Claim Rejections – 35 USC §102

Pang et al.

Claims 1-2 and 4 are rejected under 35 USC §102 as allegedly being anticipated by Pang *et al.* (US Patent No. 5,681,854). As discussed above, claim 1 as amended recites “primary open angle glaucoma” and particular HDAC inhibitors. Pang *et al.* do not teach that the HDAC inhibitors in claim 1 can be used to treat primary open angle glaucoma. Consequently, Pang *et al.* cannot anticipate the claims. Thus, Applicant respectfully requests that this ground of rejection be withdrawn.

Xiao

Claims 1-2 and 4 are rejected under 35 USC §102 as allegedly being anticipated by Xiao (US Patent No. 7,250,514). As discussed above, claim 1 as amended recites “primary open angle glaucoma” and particular HDAC inhibitors. Xiao specifically suggests that *neovascular* glaucoma may be treated with certain HDAC inhibitors, but does not teach or suggest that the HDAC inhibitors in claim 1 can be used to treat primary open angle glaucoma, which is a non-vascular glaucoma. Consequently, Xiao cannot anticipate the claims. Thus, Applicants respectfully request that this ground of rejection be withdrawn.

D. Double Patenting

Claims 1-2 and 4 are provisionally rejected as allegedly unpatentable over claims 1-2 and 4-5 of copending Application No. 10/694,309 and claims 1-2 and 4 of copending Application No. 11/836,309. Applicant is filing appropriate terminal disclaimers with this response and respectfully request reconsideration.

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CONCLUSION

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 615-5330 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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